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Supreme Court, U.S.
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No. 03-1208

IN THE

Supreme Court of the United States

JOHN JOSEPH OKULEY,

Petitioner,

v.

E.I. DU PONT DE NEMOURS AND COMPANY,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

BRIEF IN OPPOSITION

C. CRAIG WOODS
Counsel of Record
GREG R. WEHRER
P. BRIAN SEE
SQUIRE, SANDERS & DEMPSEY L.L.P.
1300 Huntington Center
41 South High Street
Columbus, Ohio 43215
(614) 365-2825

Attorneys for Respondent

186592

CP

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QUESTIONS PRESENTED

1. Whether a contract-based claim to ownership of a patent necessarily invokes a question of patent law, and thus the jurisdiction of the Federal Circuit, in the absence of any federal claim in the well-pleaded complaint?

2. Whether it is necessary to first construe the subject matter and define the inventor of a patent before determining the patent's ownership pursuant to valid contracts?

CORPORATE DISCLOSURE STATEMENT PURSUANT TO RULE 29.6

Respondent E.I. du Pont de Nemours and Company ("DuPont") states that it has no parent company, and no publicly held company owns 10% or more of DuPont's stock.

TABLE OF CONTENTS

	Page
Questions Presented	i
Corporate Disclosure Statement Pursuant To Rule 29.6	ii
Table Of Contents	iii
Table Of Cited Authorities	v
Statutory Provisions Involved	1
Statement Of The Case	3
A. Abbreviated Statement of Facts	4
B. Procedural Posture	10
Reasons For Denying The Petition	12
I. The Sixth Circuit Correctly Determined That It Had Jurisdiction Over This Appeal Because No Question Of Patent Law Was Invoked By The Complaint Below, And There Is No Compelling Reason To Review That Decision	13
A. DuPont's Well-Pleaded Complaint Asserted Only State Contract Law Claims	13

Contents

Page

B. Determining Inventorship Is Not A Necessary Predicate To Determining Ownership Of A Patent 15

C. Okuley's Inventorship Counterclaim Did Not Transform The Case Into One "Arising Under" Federal Patent Law Pursuant To 28 U.S.C. § 1338(a) 18

D. The Continuation-In-Part Applications Do Not Alter The Lower Courts' Contract Law Analysis Of The Rights Of The Parties 20

II. The Lower Courts Correctly Declined To Decide The Issue Of Inventorship, And Their Decision In This Regard Raises No Compelling Issue Of Law Or Public Policy 23

Conclusion 25

TABLE OF CITED AUTHORITIES

Page

Cases:

Aerojet-General Corp. v. Machine Tool Works, Oerlikon-Buehrle Ltd., 895 F.2d 736 (Fed. Cir. 1990) 18

Airport Surface Techs., L.L.C. v. FieldTurf, Inc., 268 F. Supp. 2d 999 (N.D. Ill. 2003) 19

American Well Works Co. v. Layne & Bowler Co., 241 U.S. 257 (1916) 14

Arachnid, Inc. v. Merit Industries, Inc., 939 F.2d 1574 (Fed. Cir. 1991) 17

Beech Aircraft Corp. v. EDO Corp., 990 F.2d 1237 (Fed. Cir. 1993) 15, 16

Beghin-Say International, Inc. v. Rasmussen, 733 F.2d 1568 (Fed. Cir. 1984) 14, 24

Boggild v. Kenner Prods., Div. of CPG Prods. Corp., 853 F.2d 465 (6th Cir. 1988) 14

Chou v. Univ. of Chicago, 254 F.3d 1347 (Fed. Cir. 2001) 19

Christianson v. Colt Industries Operating Corp., 486 U.S. 800 (1988) 11, 12, 13, 14, 18

Cited Authorities

	Page
Combs v. Plough, Inc., 681 F.2d 469 (6th Cir. 1982)	14
Ethicon v. U.S. Surgical Corp., 135 F.3d 1456 (Fed. Cir. 1998), *cert. denied*, 525 U.S. 923 (1998)	16
Golan v. Pingel Enterprise, Inc., 310 F.3d 1360 (Fed. Cir. 2002)	14, 15, 19
Holmes Group, Inc. v. Vornado Air Circulation Sys., 535 U.S. 826 (2002)	11, 12, 18, 19, 20
In re Tamoxifen Citrate Antitrust Litig., 222 F. Supp. 2d 326 (E.D.N.Y. 2002)	19
Jim Arnold Corp. v. Hydrotech Systems, Inc., 109 F.3d 1567 (1997) *cert. denied*, 522 U.S. 933 (1997)	14
Kucharczyk v. Regents of the Univ. of Calif., 48 F. Supp. 2d 964 (N.D. Cal. 1999)	19
MCV, Inc. v. King-Seeley Thermos Co., 870 F.2d 1568 (Fed. Cir. 1989)	16
New Marshall Engine Co. v. Marshall Engine Co., 223 U.S. 473 (1912)	14
Regents of the Univ. of N.M. v. Knight, 321 F.3d 1111 (Fed. Cir.), *cert. denied*, 157 L. Ed. 2d 38, 124 S. Ct. 104 (2003)	19

Cited Authorities

Page

RustEvader Corp. v. Cowatch, 842 F. Supp. 171 (W.D. Pa. 1993) 17

Teets v. Chromalloy Gas Turbine Corp., 83 F.3d 403 (Fed. Cir. 1996), *cert. denied*, 519 U.S. 1109 (1998) 16-17

University of West Virginia v. VanVoorhies, 278 F.3d 1288 (Fed. Cir. 2002) 21, 22

University Patents, Inc. v. Kligman, 762 F. Supp. 1212 (E.D. Pa. 1991) 17

Statutes:

28 U.S.C. § 1332 ..... 1, 10

28 U.S.C. § 1338 ..... 1, 10, 13, 17, 18, 24

35 U.S.C. § 116 ..... 1, 10, 19, 23, 24

35 U.S.C. § 256 ..... 2, 11, 16, 19, 23, 24

Patents:

U.S. Patent No. 6,372,965 ..... 9, 23, 24

STATUTORY PROVISIONS INVOLVED

28 U.S.C. § 1332 (2002). Diversity of citizenship; amount in controversy; costs

> (a) The district courts shall have original jurisdiction of all civil actions where the matter in controversy exceeds the sum or value of $75,000, exclusive of interest and costs, and is between—
>
> (1) citizens of different States;
>
> * * *

28 U.S.C. § 1338 (2002). Patents, plant variety protection, copyrights, mask works, designs, trademarks, and unfair competition.

> (a) The district courts shall have original jurisdiction of any civil action arising under any Act of Congress relating to patents, plant variety protection, copyrights and trademarks. Such jurisdiction shall be exclusive of the courts of the states in patent, plant variety protection and copyright cases.
>
> * * *

35 U.S.C. § 116 (2002). Inventors

> When an invention is made by two or more persons jointly, they shall apply for patent jointly and each make the required oath except as otherwise provided in this title. Inventors may

apply for a patent jointly even though (1) they did not physically work together or at the same time, (2) each did not make the same type or amount of contribution, or (3) each did not make a contribution to the subject matter of every claim of the patent.

If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor. The Director, on proof of the pertinent facts and after such notice to the omitted inventor as he prescribes, may grant a patent to the inventor making the application, subject to the same rights which the omitted inventor would have had if he had been joined. The omitted inventor may subsequently join in the application.

Whenever through error a person is named in an application for patent as the inventor, or through error an inventor is not named in an application, and such error arose without any deceptive intention on his part, the Director may permit the application to be amended accordingly, under such terms as he prescribes.

35 U.S.C. § 256 (2002). Correction of named inventor

Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention

on his part, the Director may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate correcting such error.

The error of omitting inventors or naming persons who are not inventors shall not invalidate the patent in which such error occurred if it can be corrected as provided in this section. The court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the Director shall issue a certificate accordingly.

STATEMENT OF THE CASE

This case arises out of a Research Collaboration Agreement ("RCA") between Respondent E.I. du Pont de Nemours and Company ("DuPont") and Washington State University ("WSU"). DuPont brought this diversity action in the district court to confirm its contractual ownership rights to "FAD2", a plant gene it developed with WSU pursuant to the RCA. WSU never questioned DuPont's ownership of the gene, but Petitioner John J. Okuley, a former post-doctoral researcher at WSU who helped isolate FAD2, did. DuPont was thus compelled to bring this action for a judicial declaration that Okuley was legally obligated to execute certain documents which DuPont needed at the time to continue prosecuting its patent application for the invention. The patent has since issued.

At no point during the litigation has any party disputed that Okuley is, at least, a co-inventor of FAD2. From the outset, DuPont's claims have focused solely on ownership

of the invention. Okuley's employment with WSU was governed by WSU's Faculty Manual, which expressly required him to assign all intellectual property developed by him during his employment to WSU, or in this instance, to WSU's research sponsor, DuPont. Indeed, Okuley initially executed an assignment of any and all ownership rights in FAD2 to DuPont pursuant to the terms of the RCA and the Faculty Manual. Despite having signed this document and otherwise acknowledged DuPont's ownership of FAD2, Okuley nonetheless refused to execute certain documents necessary to prosecute the patent application. He subsequently claimed that he was both the sole inventor and exclusive owner of FAD2.

Both the district court and the court of appeals found in favor of DuPont, holding that the various contractual relationships existing between DuPont, WSU and Okuley clearly and unequivocally established DuPont's ownership of FAD2. Both courts also soundly rejected Okuley's arguments that the case arises under federal patent law for jurisdictional purposes, and that the ownership issue necessarily requires a determination of his sole inventorship claim. Despite his best efforts to recast those same arguments here, Okuley has not only failed to identify any error in the courts below, he has failed to articulate any valid reason why this Court should review the case.

A. Abbreviated Statement of Facts

Okuley's statement of the case is inaccurate in some respects and misleading in others. Okuley neglects to mention certain facts critical to an understanding of the case. A complete and accurate discussion of the facts is contained in the district court's decision below. (Petition Appendix ("App.") B, 19a-33a). A brief summary of these facts is set forth below.

The FAD2 gene is one of several genes encoding a fatty acid desaturase ("FAD"). A FAD is an enzyme involved in the production of fatty acids (*i.e.*, oils) in certain plants, including crop species such as soybean, corn, canola, and castor. Isolation and manipulation of genes encoding certain FADs, including FAD2, allows scientists to develop plants yielding healthier vegetable oils.[1]

In 1989 scientists from DuPont and WSU began discussing a possible collaboration to discover and isolate FAD genes. DuPont was interested in obtaining and potentially patenting certain FAD genes, including FAD2. WSU researchers were interested in obtaining access to a valuable collection of *Arabadopsis* plants DuPont maintained and was willing to contribute to the project.[2] DuPont and WSU formally entered into the RCA on December 15, 1989. Work began on the project immediately.

In November 1991, nearly two years after work under the RCA began, Okuley, who had just received his Ph.D. from the Ohio State University ("OSU"), joined the WSU faculty as a post-doctoral researcher. His employment was governed by WSU's Faculty Manual, which made clear that any intellectual property developed while in WSU's employ

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1. From time to time, the term "FAD2" is used as a shorthand reference to the gene which encodes a particular FAD. As noted above, a FAD is not a gene *per se*, but rather the product of a gene, specifically an enzyme that influences the oil composition of certain plants.

2. *Arabadopsis* is a common plant often used in plant biology research because of certain genetic traits. It is not valuable as an oilseed crop *per se*, but scientists involved in this project understood that one way to isolate FAD genes in crops of interest to DuPont was to find it first in *Arabadopsis*.

belonged to WSU, or if the work was part of a sponsored research project, to the sponsor. At the time he accepted this position, Okuley, who had no prior experience with isolation of FAD genes, understood that he would be working on this project, and that DuPont was involved in it.

Within a few weeks, Okuley began discussing the project with Jonathan Lightner, a Ph.D. candidate at WSU. Lightner told Okuley about prior efforts by scientists at DuPont and WSU to isolate FAD2. Lightner, who was involved in other projects at the time, encouraged Okuley to conduct further experiments of this nature. Lightner also gave Okuley certain lines of *Arabadopsis* DNA that Lightner had previously derived from the DuPont collection.

Okuley began these experiments in late 1991 while still at WSU, but he was asked by his immediate supervisor to pursue another strategy. Okuley thus set aside the experimental work suggested by Lightner.

In May 1992, Okuley requested that he be allowed, for personal reasons, to return to Ohio temporarily and work in a lab he "borrowed" from a former colleague at Ohio State. While in Ohio, Okuley remained on WSU's payroll and continued to work on the FAD genes project. His supervisor at WSU continued to monitor Okuley's work, though he did so primarily by way of telephone, e-mail and fax.

While working in his borrowed lab at OSU, Okuley decided to resume work on his earlier experiments. These efforts proved successful. On August 27, 1992, he sent the first of a series of faxes and e-mails to his supervisor at WSU showing experimental results to suggest that FAD2 had been isolated in *Arabadopsis*. On September 21, 1992, Okuley

confirmed these experimental results and sent a sample to DuPont, along with a letter describing his experiments. DuPont scientists later determined that the sample sent by Okuley did in fact contain a partial version of the FAD2 gene in *Arabadopsis*.

Immediately upon receipt of the DNA from Okuley, DuPont scientists began completing the full FAD2 gene sequence. Less than a month later, DuPont scientists had isolated and obtained complete gene sequences in a number of plants other than *Arabadopsis*.

DuPont filed its initial FAD2 patent application on November 17, 1992. Initially, Lightner, but not Okuley, was named in the application as an inventor. Eventually, however, Okuley succeeded in convincing a DuPont patent attorney to list him as a co-inventor along with Lightner.[3] This decision was confirmed in a letter wherein DuPont also requested that Okuley and Lightner execute assignments transferring their rights in FAD2 to DuPont, along with declarations of inventorship to be filed with the U.S. Patent and Trademark Office ("PTO"). From that point to the present, Okuley has always been listed as a co-inventor of FAD2, and no one at DuPont has suggested in any subsequent litigation that he is not.

On May 28, 1993, Okuley wrote to the DuPont patent attorney, stating "in my opinion, I feel that the naming of Jonathon [*sic*] Lightner and myself as inventors truely [*sic*]

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3. Lightner was also instrumental in this decision. Among other things, he expressed discomfort at being listed as the sole inventor. He also expressed a strong belief that Okuley should be added to the application. Ironically, Okuley now claims that Lightner should be *taken off* the application.

reflects the inventorship of the claimed subject matter in this patent application." Okuley also executed the assignment, which acknowledged his "pre-existing obligation" to DuPont, transferred any ownership interest to DuPont, and obligated him to sign any additional papers needed by DuPont to complete its patent application. On the same day, Okuley executed a Declaration and Power of Attorney form suitable for filing with the PTO, confirming that he was a co-inventor of FAD2.

In November 1993, DuPont wrote to Okuley and Lightner requesting that both execute new assignments and declarations for filing with the first of three Continuations-In-Part ("CIPs") to the original patent application. Each of the CIPs contained additional technical information generated by DuPont and WSU scientists, including Okuley. Lightner promptly complied with DuPont's request, but Okuley demurred.

Finally, on or about December 30, 1993, Okuley executed a new assignment, but not the one DuPont had sent him. Instead, using a font and type-size virtually identical to that used in the DuPont assignment, Okuley printed and signed a document which incorporated all of DuPont's terms *verbatim* except one. In lieu of the standard recitation regarding adequate consideration having been given and accepted, Okuley inserted a provision which would, if accepted by DuPont, have required DuPont to pay Okuley a "reasonable royalty for the use of this invention". Okuley then sent the altered assignment to DuPont without comment and with no indication that its terms had been changed. Okuley's alteration initially went unnoticed, but because another CIP became necessary in the interim, DuPont never had occasion to file it with the PTO.

On June 22, 1994, a DuPont patent attorney wrote Okuley requesting that he execute a new declaration and assignment in connection with the latest CIP. Okuley did not respond to the letter, so the DuPont patent lawyer wrote him again in September, 1994. This time, Okuley executed a new declaration affirming that he and Lightner were co-inventors, but he did not execute the requested assignment.

Eventually DuPont and Okuley reached impasse. Okuley refused to execute any additional documents relating to DuPont's patent application without payment of significant remuneration by DuPont. This action was thus commenced in late 1997.

Subsequent to the filing of this action in district court, DuPont determined that a number of other DuPont scientists should be added to the patent application as co-inventors, not necessarily for the work they did to complete Okuley's isolation of FAD2 in *Arabadopsis*, but rather for the work they did in deriving FAD2 from certain oilseed crops thereafter. By letters dated April 15, 1999 (prior to the filing of the cross-motions for summary judgment upon which the judgment below is based) and January 5, 2001 (following the district court's decision in favor of DuPont), DuPont formally requested that Okuley accept the proposed amendment of the patent application and execute a new declaration acknowledging his co-inventorship. Okuley, however, declined to do so.

DuPont thereafter filed a petition with the PTO seeking leave to amend inventorship without Okuley's consent. This petition was granted, and on April 16, 2002, shortly before the case was argued to the court of appeals, the patent issued as U.S. Patent No. 6,372,965 (the "'965 patent").

B. Procedural Posture

On November 3, 1997, DuPont filed a three-count complaint against Okuley in the United States District Court for the Southern District of Ohio. The complaint sought a declaratory judgment confirming DuPont's ownership of the FAD2 gene under state contract law, and specific performance of Okuley's agreement to execute documents necessary for the processing of the patent application. The complaint stated no federal claims. Jurisdiction was based solely on diversity of citizenship under 28 U.S.C. § 1332. Okuley thereafter filed counterclaims against DuPont seeking rescission of his personal assignment and a declaration that he was the sole inventor of FAD2.[4]

On November 1, 1999, DuPont and Okuley filed cross-motions for summary judgment. On December 21, 2000, the district court issued a lengthy opinion granting DuPont's motion for summary judgment and denying Okuley's. The district court found that: (a) it had no jurisdiction under 35 U.S.C. § 116 or 256, or under 28 U.S.C. § 1338, to entertain Okuley's claim that he is the sole inventor of FAD2; (b) DuPont owned the invention pursuant to its rights under the RCA with WSU;

4. In his petition, Okuley states that his counterclaim specifically sought a declaration "that there were at least two inventions", and that "he had never assigned and was never obligated to assign the new subject matter he had disclosed in the continuation-in-part applications. (Petition ("Pet.") at 5). Both statements are incorrect. His counterclaim, attached to the Petition as Appendix E, suggests that there may be more than one invention, but it does not ask for any judicial declaration on this point. The counterclaim also makes no mention whatsoever of the CIPs. Both misstatements are significant here because they tend to give the CIP issue, discussed in greater detail *infra*, a much greater degree of significance than they had in the proceedings below.

(c) Okuley was bound by WSU's Faculty Manual to assign his ownership interest in FAD2 to DuPont; and (d) Okuley's original written assignment to DuPont was valid, enforceable, and not subject to rescission. (App. C at 36a-74a).

Okuley appealed to the United States Court of Appeals for the Sixth Circuit. Shortly after submitting his proof brief, including a statement acknowledging the Sixth Circuit's jurisdiction, Okuley reversed course and filed a motion to transfer the appeal to the Federal Circuit. The Sixth Circuit referred the motion to the panel assigned to hear the merits of the appeal, so both were argued at the same time.

On September 17, 2003, the Sixth Circuit unanimously affirmed the district court. On the appellate jurisdiction issue, the Sixth Circuit held that this case does not arise under federal patent law and thus should not be transferred to the Federal Circuit. (App. B at 6a-10a). The court of appeals pointed out that under the "well-pleaded complaint" rule articulated in *Christianson v. Colt Industries Operating Corp.*, 486 U.S. 800 (1988), this case is essentially a contract dispute that does not require a determination of inventorship or any other issue of federal law in order to resolve who owns the invention. On the strength of *Holmes Group, Inc. v. Vornado Air Circulation Sys.*, 535 U.S. 826 (2002), the court of appeals also rejected Okuley's argument that "arising under" jurisdiction is created in the Federal Circuit by virtue of his counterclaim. (App. B at 10a).

The court of appeals also affirmed the district court's determination that it had no subject matter jurisdiction to review Okuley's inventorship counterclaim because the patent had not yet issued at the time the case was decided, thereby rendering any claim under 35 U.S.C. § 256 premature.

As court of appeals noted, "we consider the facts as faced by [the district court], without prejudice to a § 256 claim should Okuley choose to file such an action." (App. B at 11a).

On the merits, the court of appeals carefully reviewed the two principal contracts at issue, the RCA between DuPont and WSU and the Faculty Manual governing Okuley's employment, and it affirmed the district court's findings in all respects.

Okuley's subsequent motion for reconsideration by the original Sixth Circuit panel and/or rehearing *en banc* was denied on November 21, 2003. (App. A). He now petitions this Court for a writ of *certiorari.*

REASONS FOR DENYING THE PETITION

The petition presents no compelling reason for granting plenary review. Okuley's claimed conflict between the circuits on "arising under" jurisdiction is illusory. Given this Court's recent decision in *Holmes Group, Inc. v. Vornado, supra*, the lower courts have had little trouble applying the "well-pleaded complaint" rule of *Christianson v. Colt Industries Operating Corp., supra*, in the context of invention ownership disputes. Nor is there any compelling reason to re-examine *Holmes Group* so soon after it was decided.

Likewise, there is no real conflict between the Sixth Circuit and the Federal Circuit regarding the relatively simple proposition that it is not always necessary to examine the issue of inventorship in order to determine who owns a patentable invention – especially in cases where, as here, the claimant's right to be named as an inventor has never been at issue. Neither the court of appeals nor the district court

erred in finding it unnecessary to determine inventorship in this case, and Okuley has not identified any good reason relating either to this case or the development of the law in general that mandates re-examination of these holdings.

I. The Sixth Circuit Correctly Determined That It Had Jurisdiction Over This Appeal Because No Question Of Patent Law Was Invoked By The Complaint Below, And There Is No Compelling Reason To Review That Decision

A. DuPont's Well-Pleaded Complaint Asserted Only State Contract Law Claims

This is a diversity action which arose from contracts amongst the parties. DuPont's complaint alleged that pursuant to the RCA between DuPont and WSU, and the Faculty Manual between WSU and Okuley, ownership of FAD2 vested in DuPont. As the district court properly concluded, each of these claims "turns strictly on contract law." (App. C at 43a). None of them – either on their face or as a matter of law – require adjudication of any federal patent issues.

Whether this case "arises under" the patent laws, either for purposes of the district court's jurisdiction to decide Okuley's inventorship claims, or for purposes of determining whether the Federal Circuit has appellate jurisdiction here, turns on application of the "well-pleaded complaint" rule set forth in *Christianson v. Colt Industries Operating Corp.*, 486 U.S. 800, 808-809 (1988). If the face of the complaint presents theories independent of patent law supporting the relief sought, then such claims do not arise under the patent laws for purposes of § 1338(a), and do not confer appellate

jurisdiction on the Federal Circuit. *Id.* at 810. The well-pleaded complaint rule focuses on claims, not theories. *Id.* at 811.

Contrary to Okuley's suggestion (Pet. at 8), both the Sixth Circuit and the Federal Circuit have consistently held that contract claims such as those made by DuPont below do not "arise under" federal patent laws, even if the contracts at issue implicate patent rights. *Compare, Boggild v. Kenner Prods., Div. of CPG Prods. Corp.*, 853 F.2d 465, 468 (6th Cir. 1988) (*quoting Combs v. Plough, Inc.*, 681 F.2d 469, 470 (6th Cir. 1982) (*per curiam*) (*quoting New Marshall Engine Co. v. Marshall Engine Co.*, 223 U.S. 473, 478 (1912)), with *Beghin-Say Int'l Inc. v. Rasmussen*, 733 F.2d 1568, 1571 (Fed. Cir. 1984) (it has been "consistently held for over 130 years that contract disputes involving patents do not arise 'under any Act of Congress relating to patents,' as required by 28 U.S.C. § 1338(a)"); and *Jim Arnold Corp. v. Hydrotech Systems, Inc.*, 109 F.3d 1567, 1572 (Fed. Cir.) *cert. denied*, 522 U.S. 933 (1997) (acknowledging *American Well Works Co. v. Layne & Bowler Co.*, 241 U.S. 257, 260 (1916), and noting that "if the patentee pleads a cause of action based on rights created by a contract, or on the common law of torts, the case is not one 'arising under' the patent laws"). There is thus no conflict between the circuits on this point, much less one that needs to be addressed by this Court.

The fact that DuPont's contract claims were raised in the context of a declaratory judgment action does not change this analysis. Okuley cites *Golan v. Pingel Enterprise, Inc.*, 310 F.3d 1360 (Fed. Cir. 2002) (Pet. at 9), but there the parties had been involved in an ongoing patent infringement dispute, and the defendant had repeatedly threatened to bring an infringement action. In response, the plaintiff preemptively

filed a declaratory judgment action seeking a declaration of non-infringement. *Id.* at 1367. The *Golan* court recognized that the act giving rise to the suit was patent infringement, and that the "non-infringement" declaratory judgment action was thus itself a claim "arising under" patent law, thereby triggering appellate jurisdiction in the Federal Circuit. *Id.*

Here, in contrast, there was no "preemptive strike" by DuPont, no contemporaneous threat of a patent infringement action or other patent-related claim by Okuley, and no patent-dependent claim made by DuPont in its complaint. DuPont's declaratory judgment claim rested solely on application of state contract law to the various agreements. There is thus no inconsistency between the Sixth Circuit's decision below and the Federal Circuit's decision in *Golan*, nor is this the type of case which would warrant a "declaratory judgment exception" to the well-pleaded complaint rule.

B. Determining Inventorship Is Not A Necessary Predicate To Determining Ownership Of A Patent

In support of his contention that "arising under" jurisdiction exists here, Okuley argues, as he has at every stage of this litigation, that it is necessary as a matter of law to determine inventorship before ownership can properly be adjudicated. (Pet. at 10-11). Although he strings together snippets of dicta from various sources, none of the cases he cites in his petition support either a blanket rule or its narrow application in this context. Indeed, in *Beech Aircraft Corp. v. EDO Corp.*, 990 F.2d 1237 (Fed. Cir. 1993), a case upon which Okuley relies extensively, the Federal Circuit expressly

recognized that "inventorship and ownership are separate issues." *Id.*, at 1248.[5]

Okuley's reliance on *MCV, Inc. v. King-Seeley Thermos Co.*, 870 F.2d 1568 (Fed. Cir. 1989), is also misplaced. There the plaintiff specifically sought a correction of inventorship under 35 U.S.C. § 256, thus the case arose directly under the federal patent laws. The ownership claim asserted in *MCV* "depend[ed] solely" on the issue of inventorship because the party seeking correction of inventorship pursuant to § 256 was not listed as a co-inventor on the issued patent.[6] *MCV*, 870 F.2d at 1571.

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5. In its opinion below, the court of appeals properly recognized that the rule urged by Okuley:

> [W]ould eradicate *Beech Aircraft's* distinction between inventorship actions, arising under the federal patent law, and patent ownership actions, not arising under the federal patent law, as any patent ownership claim could hypothetically succeed on the basis that the claimant was the inventor, rather than the contractual purchaser of the invention. Such an alternative rule would also be contrary to *Christianson*.

(App. B at 9a n.1).

6. The other cases cited by Okuley for this proposition are equally unavailing. (Pet. at 18 n.7). In fact, in *Ethicon v. U.S. Surgical Corp.*, 135 F.3d 1456 (Fed. Cir. 1998), *cert. denied*, 525 U.S. 923 (1998), an action in which the plaintiff specifically alleged patent infringement and sought correction of inventorship pursuant to 35 U.S.C. § 256, the Federal Circuit acknowledged: "Questions of patent ownership are distinct from questions of inventorship." *Ethicon*, 135 F.3d at 1465, *citing Beech Aircraft*, *supra*. In *Teets v. Chromalloy Gas Turbine Corp.*, 83 F.3d 403 (Fed. Cir. 1996), (Cont'd)

As the court of appeals noted below, a classic illustration of the proper interplay between inventorship and ownership is reflected in *RustEvader Corp. v. Cowatch*, 842 F. Supp. 171 (W.D. Pa. 1993). In *RustEvader*, a father and son were issued a patent as joint inventors. The son's former employer filed suit in state court against both the father and the son to compel assignment of the patent. The defendants removed the case to federal court. The plaintiff argued that the court had no subject matter jurisdiction because its claims were strictly a matter of state contract law. The court disagreed, noting that the father was not even allegedly a party to any employment agreement. Because the claim against the father thus depended completely on a determination that he was not an inventor, a substantial question of patent law made jurisdiction proper under 28 U.S.C. § 1338. The *RustEvader* court, however, expressly recognized that if the son – who was subject to the contract claims – were the only defendant, the federal courts would not have jurisdiction. *Id.* at 173.

Here, Okuley is in the same position as the son in *RustEvader*, not the father, because his status as an inventor is undisputed. Unlike the plaintiff in *RustEvader*, DuPont

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(Cont'd)

cert. denied, 519 U.S. 1109 (1998), an action that sought, among other things, a declaration of ownership, the Federal Circuit's decision is silent regarding inventorship; it was only concerned whether an implied-in-fact contract of assignment existed between an inventor and his employer. In the remaining two cases cited by Okuley, inventorship was simply not disputed. *See Arachnid, Inc. v. Merit Industries, Inc.*, 939 F.2d 1574 (Fed. Cir. 1991) (concerning standing of a plaintiff to recover for patent infringement occurring at a time when the plaintiff had a claim of ownership but did not possess title to invention); *University Patents, Inc. v. Kligman*, 762 F. Supp. 1212 (E.D. Pa. 1991) (concerning university professor's duty to assign patent rights pursuant to faculty handbook).

does not need to prove that Okuley is not an inventor in order to prevail on its claims. Indeed, as the court of appeals noted, DuPont has consistently acknowledged Okuley's status as an inventor of FAD2 from the outset of this litigation, and he is so listed on the issued patent. (App. B at 9a n.2, 11a). Because DuPont has never contended in this case that Okuley is anything other than a co-inventor of FAD2, it is not necessary to determine whether he is the ***only*** inventor for purposes of deciding DuPont's contract-based claims.

C. Okuley's Inventorship Counterclaim Did Not Transform The Case Into One "Arising Under" Federal Patent Law Pursuant To 28 U.S.C. § 1338(a)

By implication, the well-pleaded complaint rule precludes consideration of either patent-related defenses raised in the answer or patent law counterclaims. As to defenses, this point was made manifest in *Christianson*, *supra*, 486 U.S. at 809 ("a case raising a federal patent-law defense does not . . . 'arise under' patent law"). As to counterclaims, this Court laid the issue to rest in *Holmes Group, Inc. v. Vornado Air Circulation Sys., Inc.*, 535 U.S. 826, 831 (2002), where it held unequivocally that a counterclaim cannot serve as the basis for "arising under" jurisdiction. In so holding, this Court resolved a true conflict between the circuits, effectively overruling *Aerojet-General Corp. v. Machine Tool Works, Oerlikon-Buehrle Ltd.*, 895 F.2d 736, 741-44 (Fed. Cir. 1990).

Okuley suggests that *Holmes Group* somehow raises a variety of unsettled questions regarding federal jurisdiction and has created additional conflict amongst the circuits. (Pet. at 7). He does not specify the precise nature of this

supposed conflict, however – other than to suggest that the lower courts have struggled "in delimiting federal court jurisdiction under patent law." (Pet. at 11). None of the cases he cites, moreover, actually involves the precise jurisdictional issues raised in the petition, and the facts of each are quite distinct. *See, e.g., Regents of the Univ. of N.M. v. Knight*, 321 F.3d 1111 (Fed. Cir.), *cert. denied*, 157 L. Ed. 2d 38, 124 S. Ct. 104 (2003) (Federal Circuit jurisdiction exercised when university asserted claim for declaration of inventorship); *Chou v. Univ. of Chicago*, 254 F.3d 1347 (Fed. Cir. 2001) (construing jurisdiction to correct ownership under § 256)[7]; *Airport Surface Techs., L.L.C. v. FieldTurf, Inc.*, 268 F. Supp. 2d 999 (N.D. Ill. 2003) (construing jurisdiction under § 116 and § 256); *In re Tamoxifen Citrate Antitrust Litig.*, 222 F. Supp. 2d 326 (E.D.N.Y. 2002) (antitrust and consumer protection claim).[8]

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7. In *Chou*, the Federal Circuit criticized the holding of the district court below, along with similar holdings by other district courts, that an inventor who does not own an invention may not have standing under § 256 to sue for correction of the patent. *See Kucharczyk v. Regents of the Univ. of Calif.*, 48 F. Supp. 2d 964 (N.D. Cal. 1999). As noted *infra*, however, this issue was effectively abandoned below, and it is not before this Court. In any event, *Chou* is readily distinguishable inasmuch as the inventor there was suing to be included in the patent and claimed a "reputational interest" in being named as an inventor. Here, of course, Okuley is a named inventor already, and he seeks only to "bump" his former colleagues off the patent.

8. Indeed, one of the cases cited by Okuley, *Golan v. Pingel Enterprise, Inc.*, 310 F.3d 1360 (Fed. Cir. 2002), discussed *supra*, suggests there is no confusion whatsoever about *Holmes Group*. There the Federal Circuit made it clear that in the wake of *Holmes Group*, the fact that the defendant had filed a patent infringement counterclaim "is irrelevant to our jurisdiction." *Golan*, 310 F.3d at 1367.

There was certainly no confusion on the part of the court of appeals here. That court, citing *Holmes Group*, dealt with the issue in a footnote and pointed out simply that even if Okuley had standing under the patent laws to press his sole inventorship claims, they "do not affect the issue of appellate jurisdiction" because they were all counterclaims. (App. B at 10a n.3). Nowhere in his petition does Okuley claim that the court of appeals misapplied *Holmes Group*, or that another circuit has applied it differently to these facts. His argument appears to be simply that *Holmes Group* was wrongly decided.

Indeed, the bulk of the petition appears to be a thinly-veiled plea for reconsideration of *Holmes Group*. Okuley, however, has failed to demonstrate why this Court, just two years after deciding *Holmes Group*, should need or want to take another look at the issues decided there. Even if he had, he has failed to show how or why this case would serve as a suitable vehicle for such reconsideration, much less what compelling point of law would be settled by granting *certiorari* here.

D. The Continuation-In-Part Applications Do Not Alter The Lower Courts' Contract Law Analysis Of The Rights Of The Parties

In his petition, Okuley also claims that the existence of CIPs related to the FAD2 patent renders DuPont's contract claims and his own inventorship counterclaim "inseparable". (Pet. at 10). The CIPs, however, have absolutely no bearing on the contract-based analysis that led both courts below to conclude under state law that DuPont owns the FAD2 patent, and that led the Sixth Circuit to conclude that it had jurisdiction over the appeal.

The court of appeals properly resolved this issue when it affirmed the district court's finding that the CIPs encompassed additional work which was a "simple extension of the original patent application" and had no impact on Okuley's ***contractual*** duty to assign any additional ownership interest. (App. B at 16a). The district court specifically found that there was no need to determine whether Okuley's additional work constituted a new generalized claim because, even if it did, he had a contractual obligation to assign his rights in that new claim to DuPont. (App. C at 72a).[9]

Okuley's discussion of *University of West Virginia v. VanVoorhies*, 278 F.3d 1288 (Fed. Cir. 2002), does not change this conclusion. In that case, the plaintiff invented an antenna while a graduate student at the University of West Virginia ("WVU"). Pursuant to WVU's patent policy, VanVoorhies assigned his rights in the invention, and in any CIPs, to the University. After his graduation, VanVoorhies revised the initial antenna design. A dispute arose as to whether the new design was properly the subject of a CIP, or a separately patentable invention. The Federal Circuit exercised jurisdiction over the appeal because ownership rights in the revised design could only be determined by first deciding

9. In his petition, Okuley raises this issue in connection with the appellate jurisdiction question. (Pet. at 10-11 and 25). In the district court, however, the issue arose in the context of summary judgment, *i.e.*, whether that court could properly grant summary judgment without having to determine whether the CIPs somehow reflected a new or different invention. The district court's determination that Okuley's contractual obligations were so broad that they would have encompassed even a new invention is equally applicable to the question of whether Okuley's CIP claims are so "inseparable" from DuPont's ownership claims that such claims necessarily "arise under" federal patent law. As the court of appeals found, they are not. (App. B at 16a).

whether, as a matter of patent law, the new design was properly the subject of a CIP. Thus *patent law*, and not any contract, was determinative of ownership.

In this case, unlike *VanVoories*, DuPont's right to relief rested entirely on the terms of the applicable contracts, not on any question of patent law. The courts below correctly concluded that Okuley's contractual obligation to assign his ownership interest to DuPont was so broad and so unambiguous that it would apply to any work done by Okuley on FAD2, even if such work was not specifically described in the patent application until one or more of the CIPs were submitted.

Okuley spends a great deal of time in his petition attempting to convince the Court that there is "new subject matter" in the '965 patent (which, of course, had not even issued when the district court handed down its decision). He spends no time, however, discussing how or why this new subject matter would not also be covered by the same contractual obligations that bound him to assign the "original" invention to DuPont. As the district court expressly recognized, whether or not Okuley made an inventive contribution to some allegedly "new" claim in the FAD2 patent has absolutely no bearing on the contract issues raised in the complaint, nor does it provide any basis for asserting that appellate jurisdiction lies with the Federal Circuit.

II. The Lower Courts Correctly Declined To Decide The Issue Of Inventorship, And Their Decision In This Regard Raises No Compelling Issue Of Law Or Public Policy

The petition also raises a distinct, but nonetheless related, question as to whether the lower courts properly declined to decide Okuley's inventorship counterclaim. (Pet. at 25-28). Okuley claims that they should have decided the question, but he completely ignores both the basis for their decision and the fact that he largely abandoned this issue below.

The district court and the court of appeals both properly concluded that they lacked jurisdiction to consider Okuley's counterclaim. At the time the district court case was pending, the FAD2 patent had not yet issued. Both of the lower courts noted that 35 U.S.C. § 116 gives the Director of the PTO the right to correct inventorship on a pending application, but does not bestow a corresponding right on the courts. Both courts thus held that the absence of language in § 116 specifically creating such authority necessarily deprived the district court of subject matter jurisdiction over Okuley's inventorship claim. (App. B at 11a). They also held that 35 U.S.C. § 256 did not confer jurisdiction because § 256 applies only to issued patents. As the court of appeals noted, the subsequent issuance of the '965 patent does not change this analysis because the district court rendered its judgment well beforehand. (App. B at 11a-12a).

As the court of appeals also pointed out, Okuley, in the appeal below, essentially dropped any argument that 35 U.S.C. § 256 was applicable, and "merely made a perfunctory statement that § 116 vests jurisdiction in the courts implicitly * * *." (App. B at 12a). He now effectively

urges this Court, however, to judicially rewrite both § 116 and § 256 by taking up this case for the purpose of holding that inventorship must always be considered and determined in disputes over the ownership of a patentable invention. Such a rule would neither be consistent with existing statutory law nor warranted under the circumstances presented here.

In the words of the Federal Circuit, this is "a contract suit, pure and simple." *Beghin-Say International, Inc. v. Rasmussen*, 733 F.2d 1568, 1571 (Fed. Cir. 1984). Indeed, if a named inventor can turn a contract dispute into a case "arising under" the patent laws simply by claiming that other inventors were named improperly in the patent application, then virtually all ownership disputes would be subject to § 1338(a), and the statutory scheme for determining inventorship questions under §§ 116 and 256 would effectively be eviscerated. Over 150 years of collected wisdom and case law argue against such a sweeping change, and Okuley has not identified any sound argument to support one.

CONCLUSION

For the foregoing reasons, Okuley's petition for a writ of certiorari should be denied.

Respectfully submitted,

C. CRAIG WOODS
Counsel of Record
GREG R. WEHRER
P. BRIAN SEE
SQUIRE, SANDERS & DEMPSEY L.L.P.
1300 Huntington Center
41 South High Street
Columbus, Ohio 43215
(614) 365-2825

Attorneys for Respondent